

Remarks

Claims 2-4, 6-10, 18-30, and 34-36 are pending. Claims 31 to 33 are currently canceled. Claims 25-30 have been withdrawn from consideration. Claims 19, 20, 23, 24, and 25 are currently amended. New claims 34 to 36 are currently added. Reconsideration of the application, as amended, is requested.

Support for the amendments to claims 19 and 20 can be found in the specification, for example, page 2, line 29 to page 3, line 9, where it states that for partial condensates and complete condensates, respectively, some or most of the hydrolysable groups have reacted. This implies that the compositions are derived from partial or complete condensation reactions.

Claim 23 is currently amended to refer to claim 22, which describes a method for treating a substrate. The "treated" substrate is now recited in claim 23 to make the language more consistent between the two claims.

Support for the amendment to claim 24 with respect to the limitation "where R¹ is hydroxyalkyl, dihydroxyalkyl, or polyalkylenepolyamine and R² is hydrogen or R¹" can be found in the specification, for example, on page 4, lines 14-17 and page 6, lines 22-25. Further argument that the term "dihydroxyalkyl" is implicitly disclosed in the application as filed is provided below in the response to the 35 USC § 112, first paragraph rejections.

Support new claim 34, can be found in the specification, for example, on page 4, lines 14-17 and page 6, lines 22-25. Further argument that the term "dihydroxyalkyl" is implicitly disclosed in the application as filed is provided below in the response to the 35 USC § 112, first paragraph rejections.

Support for new claims 35 and 36 can be found in the application as filed. The limitation in claim 35, which includes R¹ is dihydroxypropyl, and the limitation in claim 36, where R¹ is dihydroxypropyl and R² is hydrogen, are supported by the specification, for example, Preparations 2, 4, 5, and 6 on pages 19-21, where "APD" is defined as 2-amino-1,3-propanediol

on page 18. Further support for R^2 is hydrogen can be found in the specification, for example, page 6, line 25. In claim 36, R^1 is defined, in part, as hydroxyalkyl or polyalkylenepolyamine, which is supported, for example, by original claim 5, and R^2 is defined, in part, as hydrogen or R^1 , which is supported by the specification, for example, page 6, line 25.

The specification was amended in the response filed on March 16, 2009, on pages 4, 7, 8, 20, and 21 to correct punctuation or typographical errors.

§ 112 Rejections

Claims 2-4, 6-10, and 18-24 were rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

The Office Action stated that with respect to claims 19 and 20, the use of the word, "derivable", renders the claims indefinite. While not necessarily agreeing with the rejection, to facilitate prosecution amended dependent claims 19 and 20 now state that said composition is derived from a partial (claim 19) or a complete (claim 20) condensation reaction of components (a), (b) and (c). The word "derivable" is currently deleted from these claims.

With respect to independent claim 24, the Office Action points out that the word, "dihydroxyalkylene", has been misspelled. Claim 24 is currently amended to replace "dihydroxyalkylene" with "dihydroxyalkyl".

In summary, Applicants submit that the rejection of claims 2-4, 6-10 and 18-24 under 35 USC § 112, second paragraph, has been overcome and request withdrawal of the rejection.

Claims 2-4, 6-10, and 18-24 were rejected under 35 USC § 112, first paragraph, as failing to comply with the written description requirement.

The Office Action states:

Adequate support has not been provided for the inserted "dihydroxyalkylene" and inserted proviso limitations of claim 24. Despite applicants' response, it is by no means clear that applicants were in possession of the instantly claimed subject matter at the time of invention.

Firstly, it is not clear from exactly where support stems for the amended subject matter. Secondly, if applicants intend support to stem from the use of aminoethanol and 3-amino- 1,2- propanediol within the examples, then the

position is taken that such limited examples fail to provide support for the full scope of subject matter encompassed by the claims, as amended.

Applicants traverse the rejection and submit that one skilled in the relevant art would have understood that the inventors, at the time the application was filed, had possession of the claimed invention. With respect to the rejection based on the term "dihydroxylalkylene" (or "dihydroxyalkyl"), Applicants respectfully point out that according to MPEP § 2163.02, "The subject matter of the claim need not be described literally (i.e., using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement." Also, MPEP § 2163.05 states, "To comply with the written description requirement of 35 U.S.C. 112, para. 1, or to be entitled to an earlier priority date or filing date under 35 U.S.C. 119, 120, or 365(c), each claim must be expressly, implicitly, or inherently supported in the originally filed disclosure."

Applicants submit that the limitation, where R^1 and R^2 are each independently dihydroxyalkyl, is implicit in the original disclosure. The limitation, where R^1 and R^2 are each independently dihydroxyalkyl, is supported by the specification, for example, Preparations 2, 4, 5, and 6 on pages 19-21, where "APD" is defined as 2-amino-1,3-propanediol on page 18. These preparations exemplify compositions wherein one of R^1 or R^2 is dihydroxypropyl, an example of dihydroxyalkyl. These Examples should be considered in light of the disclosure, for example, on page 4, lines 16-17, where it states, " R^1 and R^2 are each independently hydrogen, hydroxyalkyl, or polyalkylenepolyamine", which indicates to one skilled in the art that hydroxyalkyl groups, in general, can be used for R^1 , R^2 , or both. Since similar methods are used to make compounds of formula I having hydroxyalkyl or dihydroxyalkyl groups, and since hydroxyalkyl groups in general were disclosed, one skilled in the art reading the specification would understand that the inventors were in possession of dihydroxyalkyl groups generally and the exemplified dihydroxypropyl group at the time the application was filed.

With respect to the proviso limitation, "with the proviso that both R_1 and R_2 are not hydrogen at the same time", Applicants have deleted this limitation from claim 24 and replaced it with the limitation "where R^1 is hydroxyalkyl, dihydroxyalkyl, or polyalkylenepolyamine and R^2 is hydrogen or R^1 ". The amendment is supported by the specification as described above.

In summary, Applicants submit that the rejection of claims 2-4, 6-10 and 18-24 under 35 USC § 112, first paragraph, has been overcome and request withdrawal of the rejection.

New claims 34-36 are each dependent from claim 24. The rejection of claim 24 has been overcome, as described above. Therefore, claims 34-36 are likewise patentable. Furthermore, claims 35 and 36 include the selection wherein R¹ is dihydroxypropyl, which is exemplified, instead of dihydroxyalkyl.

With this response, an earnest effort has been made to respond to all issues raised in the Notice of Non-Compliant Amendment. In view of the above, it is submitted that the application is in condition for allowance and reconsideration of the application is requested.

Respectfully submitted,

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